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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/690,257	10/21/2003	Oscar A. Chappel	92717-345USP1	3421

7590

07/17/2006

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EXAMINER

BUSS, BENJAMIN J

ART UNIT

PAPER NUMBER

2129

DATE MAILED: 07/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/690,257	CHAPPEL, OSCAR A.	
	Examiner	Art Unit	
	Benjamin Buss	2129	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10/21/2003 and 11/17/2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2003 and 17 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>7/26/04, 8/2/04, 8/15/05, 1/17/06, 2/21/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-21 are pending in this application.

MPEP 2111 states that during patent examination, the pending claims must be "given their broadest

5 reasonable interpretation consistent with the specification." The Examiner has determined the broadest reasonable interpretation of the claims based on the terms used. Claim 1 is interpreted to be met by:

- Any comparison between a converted input and a rule, such as a conditional statement (IF ... then ...);
- Doing anything based on the result of the comparison (if ... THEN ...), such as
- Storing something as a result of the above.

10 By way of example, the broadest reasonable interpretation of claim 1 is met by: "IF (digital numeric representation of an alphanumeric or analog input) > 0 THEN store the digital numeric representation."

Examiner suggests that Applicant consider further defining at least the following broad terms in the claims:

- Claim
- 15 - Conclusion variable
- Edit
- Expanding
- Filtering
- Rule
- 20 - Syntax
- Translating
- Validating
- Verifying

25 **Priority**

Examiner acknowledges Applicant's claim for priority as a **continuation-in-part** of 10/336,104 filed on 1/3/2003, which is a **continuation-in-part** of 09/859,320 filed on 5/16/2001. Examiner also acknowledges Applicant's incorporation of 10/690,258 filed on 10/21/2003.

30 ***Information Disclosure Statement***

The information disclosure statement filed 8/2/2004 fails to comply with the provisions of 37 CFR 1.97, 1.98 and MPEP § 609 because Cite No. C6 does not include a date of publication. It has been placed in the application file, but the information referred to therein has not been considered as to the merits. Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission
35 of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

Claim Rejections - 35 USC § 101

40 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

45 Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The computer system must set forth a practical application of that §101 judicial exception to produce a real-world result. Benson, 409 U.S. at 71-72, 175 USPQ at 676-77. The invention is ineligible because it has not been limited to a substantial practical application. The claims are directed to abstract manipulation of abstract data, the data being labeled as an "edit", and are therefore directed to mere abstract ideas.

50 In determining whether the claim is for a "practical application," the focus is not on whether the steps taken to achieve a particular result are useful, tangible, and concrete. If the claim is directed to a practical application of the §101 judicial exceptions producing a result tied to the physical world that does not preempt the judicial exception, then the claim meets the statutory requirement of 35 U.S.C. §101.

The phrase "populating the knowledge base" is not clear in purpose or scope. The claims neither
55 encompass a physical transformation nor do they produce a useful, concrete, tangible result. The knowledge base is interpreted to be abstract.

The invention must be for a practical application and either:

1) specify transforming (physical thing – article) or

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2) have the Final Result (not the steps) achieve or produce a
useful (specific, substantial, AND credible),
concrete (substantially repeatable/non-unpredictable), AND
tangible (real world/non-abstract) result
(tangibility is the opposite of abstractness).

A claim that is so broad that it reads on both statutory and non-statutory subject matter must be amended,
and if the specification discloses a practical application but the claim is broader than the disclosure such that it does
not require the practical application, then the claim must be amended.

Claims that manipulate abstract data through rule-based filtering, determine abstract matches, and
populate an abstract knowledge base are not statutory.

Appropriate corrections are required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections
under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on
sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-21 are rejected under 35 U.S.C. 102(b) as being anticipated by **Carrer** ("An Annotation Engine for
Supporting Video Database Population").

Claims 1, 8, & 15:

Carrer anticipates:

- Filtering a translated edit via at least one rule to determine a match between a syntax of the translated edit
and a syntax of the rule (p233-253 especially that the raw video is edited into frames, shots scenes, etc.,
which are translated semi-automatically through the annotation process, then the SGML parser filters to
ensure that the translated edit is consistent with the context rules, supporting intuitive concepts such as
"equal to" and "similar to" §4.1; Also that the SGML annotation is an edit itself which is "translated to

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different output formats such as HTML" or SQL and matched to the mapping of a database based on mapping rules §5; Also see Figure 3);

- 90 - Executing a method call responsive to the filtering step resulting in at least one match being determined (p233-253 especially the "notification of mismatches between the opened annotations and the corresponding DTD" §4.1 and "if no errors are found at this stage then the tool reads the DTD-to-database-map file" §5; Also "loading in the relevant contents from the SGML annotation file" §5); and
- 95 - Populating the knowledge base responsive to the executing step (p233-253 especially "resultant annotations are stored as metadata using SGML" §5 and "mapping between various table attributes to the fields in the database" §5 and "the database module writes the appropriate fields to the database" §5; Also see Figure 8).

Claims 2, 9, & 16:

100 **Carrer** anticipates:

- Translating an edit to yield the translated edit (p233-253 especially the annotation process described in §4.2-§4.3; Also "translated to different output formats such as HTML" or SQL §5).

Claims 3, 10, & 17:

105 **Carrer** anticipates:

- Binding at least one conclusion variable responsive to the filtering step (p233-253 especially "metadata" §4.1; Also the attributes extracted as field values in §5).

Claims 4, 11, & 18:

110 **Carrer** anticipates:

- Expanding the at least one conclusion variable (p233-253 especially the extraction of attributes in §5 and "resultant annotations are stored as metadata using SGML" §5); and
 - Creating an instance of a code object corresponding to the called method (p233-253 especially the loading of fields from the SGML annotation file as described in §5 and "resultant annotations are stored as metadata using SGML" §5).
- 115

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Claims 5, 12, & 19:

Carrer anticipates:

- Validating a claim using the populated knowledge base (p233-253 especially that in answering a query, Vane is checking the validity of the claim that the query matches each item stored in the database, thus facilitating indexing and searching of the content §2.2; Also, the annotator's claimed interpretation of the content can be validated by combining the results of multiple annotators for the same content to compensate for subjectivity and add detail to support information retrieval §4.1.4).

Claims 6, 10, & 20:

Carrer anticipates:

- Adding information contained in the created code-object instances to the knowledge base (p233-253 especially "After loading the relevant contents from the SGML annotation file, the database interface module writes the appropriate fields to the database" §5).

Claims 7, 10, & 21:

Carrer anticipates:

- Verifying that the edit has been correctly translated (p233-253 especially the "notification of mismatches between the opened annotations and the corresponding DTD" §4.1 and "if no errors are found at this stage then the tool reads the DTD-to-database-map file" §5)

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Fitzgerald (USPAP 2003/0191667)
- Haskey (USPAP 2003/0208379)
- Rao (USPAP 2005/0137912)
- Kole (USPAP 2003/0167184)
- Beazley (USPAP 2003/0149594)

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- Kirsh (USPAP 2001/0034621)
- 145 - Bence, Jr. (USPN 6,484,178)
- Green (USPAP 2002/0040359)
- Wilson (USPAP 2005/0102169)
- Rowe, III (USPAP 2004/0078247)
- Dudley (USPAP 2004/0006495)
- 150 - Chapman (USPN 6,879,959)
- Simpson (USPN 6,266,645)
- Sanin (USPAP 2004/0073811)
- Skeirik (USPN 4,920,499)
- Lawrence (USPN 6,999,959)
- 155 - Spiro (USPN 5,819,228)
- SAITO (JPPN 403020866)
- Gaizauskas ("Information extraction: beyond document retrieval")
- Zarri ("NKRL, a knowledge representation language for narrative natural language processing")
- fP Technologies ("FastEMC 6.2: UB92 Electronic Claims Submission System – Manual")
- 160 - Shaker ("A rule driven bi-directional translation system for remapping queries and result sets between a mediated schema and heterogeneous data sources")
- Heinze ("LifeCode – a deployed application for automated medical coding")

Claims 1-21 are rejected.

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Correspondence Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Benjamin Buss whose telephone number is 571-272-5831. The examiner can normally be reached on M-F 9AM-5PM.

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170 As detailed in MPEP 502.03, communications via Internet e-mail are at the discretion of the applicant. Without a written authorization by applicant in place, the USPTO will not respond via Internet e-mail to any Internet correspondence which contains information subject to the confidentiality requirement as set forth in 35 U.S.C. 122. A paper copy of such correspondence will be placed in the appropriate patent application. The following is a sample authorization form which may be used by applicant:

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authorize the USPTO to communicate with me concerning any subject
matter of this application by electronic mail. I understand that a copy of
these communications will be made of record in the application file."

180 If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Vincent
can be reached on 571-272-3080. The fax phone number for the organization where this application or proceeding
is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information
Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or
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185 information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the
Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Benjamin Buss
Examiner
Art Unit 2129

190 BB

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SUPERVISORY PATENT EXAMINER